

REMARKS

Applicants have reviewed the Office Action of June 18, 2003 and have provided the following remarks. Reconsideration is earnestly requested.

Request to Withdraw the Finality of the Office Action

Applicants request the withdrawal of the finality of the Office Action. On page 7 of the Office Action mailed June 18, 2003, the Office Action alleges that Applicants' amendment necessitated the new ground(s) of rejection. Applicants respectfully disagree. The amendments made in the response to Office Action mailed January 3, 2003 were responsive to the Examiner's rejection under 35 U.S.C. § 101. M.P.E.P § 706.07(a) states that a subsequent action on the merits in any application should not be made final if it includes a rejection of any claim amended to include limitations which should reasonably have been expected to be claimed¹. In this case, it is reasonable to expect that Applicants would amend the claims to overcome the Examiner's rejection under 35 U.S.C. § 101. Therefore, the amendments do not necessitate the new grounds of rejection.

Furthermore, the Office Action rejects claims 59, 60, 64, 65, 73, 74 and 75 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. These claims were not amended in the response to Office Action mailed January 3, 2003. The new rejection under 35 U.S.C. § 112, first paragraph was not made in the Office Action mailed January 3, 2003. The current rejection introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information

¹ For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element. M.P.E.P 706.07(a).

submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c). According to M.P.E.P 706.07(a), any subsequent action on the merits cannot be made final under these circumstances. For at least the reasons stated above, the finality of the rejection should be withdrawn.

Information Disclosure Statement

The Examiner is respectfully requested to consider all the cited references listed in the Information Disclosure Statement that was submitted on May 19, 2000 by initialing in the space provided next to each cited reference on the Form PTO-1449 and return a copy of the same with the next communication to the Applicants. The Information Disclosure Statement was submitted before the mailing of the first Office Action. Only the first page of the Form PTO-1449 was returned with the Examiner's initials.

Claim Rejections under 35 U.S.C. § 112

Claims 59, 60, 64, 65, 73, 74 and 75 are presently rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Office Action alleges that the specification as originally filed, does not provide support for the invention as is now claimed, i.e., the phrase "a predetermined level" and the phrase "a predetermined time" do not appear in the originally filed claims or originally filed specification. Applicants respectfully disagree. The claim features are properly described in the application as originally filed. More specifically, with respect to the "a predetermined level" limitation, at least Figure 1 and page 5, lines 3-14 of the specification originally filed support this limitation. For example, claims 59 and 60 recite "a level of value" above or below "the predetermined level," where the "predetermined level" as initially claimed in claim 58 refers to

“determining whether a level of value to the client is above a predetermined level.” This feature, according to one example of an embodiment of the present invention, is referring to whether there is a high value to the client in having such services performed 110. If the answer is yes, the service is assigned to the core service group 120 and if the answer is no, the service is assigned to the non-affiliated group 140. To determine whether there is a *high value* to the client, there must be a comparison involving a level with respect to another predetermined level to qualify as a *high value*. Therefore, this concept is fully disclosed in the specification as originally filed.

With respect to “a predetermined time” limitation, at least Figure 3 fully supports this concept. More specifically, in the flowchart of Figure 3, services from the affiliated service provide group 350 and service from the non-affiliated service provider group 355 are provided *after* services from the core service provider group 340. This feature is reflected in claim 64. However, for the purpose of expediting prosecution, this phrase has been deleted. For consistency, claim 72 has also been amended.

As commonly known and generally understood, the term “predetermined” may refer to a value or a time that is determined beforehand. As these features are clearly supported in the application as originally filed, the rejection should be withdrawn.

The Office Action alleges that claims 65, 73, 74 and 75 recite features that are not supported by either the originally filed specification or in the originally filed claims. Applicants respectfully disagree. The features of claims 65, 73, 74 and 75 were originally recited in the original claims, filed with the application. More specifically, the limitations directed to international trusts services *were originally presented in claim 17*); public relations services *were originally presented in claim 19*; crisis management services *were originally presented in claim*

17; coordination and direction of charitable activities services *were originally presented in claim 25*; background checks on personal staff or other parties services *were originally presented in claim 26*; offering of investment opportunities not available to non-clients services *were originally presented in claim 27*; development and execution of debt reduction strategies services *were originally presented in claim 28*; development and maintenance of education funds services *were originally presented in claim 29*; advice and care of minors, invalids, elderly, incompetents or other persons services *were originally presented in claim 30*; business succession planning services *were originally presented in claim 32*; issuance of loans, traveler's checks, foreign currency, credit or other banking services *were originally presented in claim 33*. In addition, the limitations of claims 74 and 75 directed to mining data and synthetic logic tool *were originally presented in claims 55-57*. As these features are all supported in the originally filed application and the originally filed claims, the rejection should be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 58-64, 66-72 and 74-75 are presently rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,430,542 to Moran ("Moran"), U.S. Patent No. 5,918,207 to McGovern *et al* ("McGovern") and the VIP Forum, Fact Brief, Family Services, February 2000 ("VIP Forum"). Claims 65 and 73 are presently rejected under 35 U.S.C. § 103(a) as being unpatentable over Moran, McGovern and VIP Forum, as applied to claims 58 and 66, and further in view of Bruce Upbin, "Old Money Chasing New," Forbes, June 15, 1998, vol. 161 issue 12 ("Upbin").

Moran appears to be directed to a computer-implemented program for financial planning and advice. With the financial and advice system of Moran, an advisor can analyze a client's

relationship(s) with his/her family, business and pension to provide overall financial planning and security. The Office Action admits the major deficiencies of Moran. In other words, the Office Action admits that out of the seven major elements of claims 58 and 66, Moran fails to disclose five of them. More specifically, the Office Action acknowledges that Moran fails to show the features directed to: (c) *assigning a plurality of services to a plurality of service provider groups*, further comprising the steps of: (i) *determining whether each service is needed by the client on a frequent basis*; (ii) *determining whether a level of value to the client is above a predetermined level*; and (iii) *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server*; and (d) *providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display*, as recited in independent claim 58. Corresponding limitations are recited in independent system claim 66.

Recognizing the significant deficiencies of Moran, the Office Action then asserts that McGovern combined with VIP Forum allegedly disclose the missing five out of seven major elements from Moran, without any proper motivation to combine. The Office Action alleges that McGovern discloses automatic searches of candidates to match customer's needs and present the candidates in ranking order relative to the client's needs. The Office Action goes on to assert that VIP Forum determines needs and makes assignments and referrals. In light of the alleged ranking feature of McGovern and VIP Forum, the Office Action finds motivation based on

obtaining “a cost-efficient way of providing referrals to various professionals and specialists.”

McGovern appears to be directed to a process and system for predictive resource planning to allow a service provider to meet a customer’s predicted technical resource requirements. McGovern involves determining a service providers’ technology baseline, determining a customer’s technology direction; and predicting the customer’s technical resource requirements. The skill levels of candidate employees are documented and the candidates meeting the predicted technical resource requirements are selected. The invention of McGovern is completely unrelated to providing personalized financial services to a client, as claimed by Applicants. Further, there is no teaching or suggestion of the admitted missing elements of Moran. More specifically, McGovern makes absolutely no mention and provides no teaching of “assigning a plurality of services to a plurality of service provider groups, further comprising the steps of: (i) *determining whether each service is needed by the client on a frequent basis*; (ii) *determining whether a level of value to the client is above a predetermined level*; and (iii) *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining.*” At least these limitations are not taught by McGovern. In fact, the Office Action makes no attempt to point to any teaching or disclosure in McGovern that addresses the combination of claim limitations. McGovern’s alleged ranking disclosure does not obviate the combination of claim limitations.

The third reference, VIP Forum, provides nothing more than a listing of services provided by different banks.

The rejection over Moran, McGovern and VIP Forum is a classic example of hindsight

reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”). Here, the Office Action combines three disparate references, each of which are directed to different goals, to allegedly yield the independent claims.

The Office has failed to set forth a *prima facie* case of obviousness for the independent claims. Additionally, it does not even attempt to establish a *prima facie* case of obviousness for the further modifications proposed to yield the dependent claims either. Furthermore, the fact that three disparate references are needed in combination to address Appellant’s claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, *Chisum on Patents* §5.04[I][e][6] (2002).

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the

time of the invention.

In the present case, the Office Action's sole justification for modifying Moran in view of McGovern and VIP Forum has absolutely nothing to do with the deficiencies of Moran. Moran is alleged to teach a computer-implemented program for financial planning and advice system, but lacks any disclosure related to assigning a plurality of services to a plurality of service provider groups involving the steps of determining whether each service is needed by the client on a frequency basis, determining whether a level of value to the client is above a predetermined level; and categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining. Moreover, Moran lacks providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group. To properly modify Moran to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Moran. Any such motivation is completely lacking.

Accordingly, the Office has failed to provide any proper motivation for modifying Moran in view of McGovern and VIP Forum, so the proposed three-reference combination fails. Even if these disparate references could be combined, the resulting combination fails to show each and every limitation claimed by Applicants.

The Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to combine the computer-implemented program of Moran with the predictive resource planning system of McGovern and further combined with the services of VIP

Forum. The mere fact that three references can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that “the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill.” The court also stated that “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art” (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

Claims 65 and 73 are presently rejected under 35 U.S.C. § 103(a) as being unpatentable over Moran, McGovern and VIP Forum, as applied to claims 58 and 66, and further in view of Bruce Upbin, “Old Money Chasing New,” *Forbes*, June 15, 1998, vol. 161 issue 12 (“Upbin”). The Upbin article fails to make up the deficiencies of the combination as applied to claims 58 and 66. For at least the reasons stated above, claims 65 and 73 are patentable and the rejection should be withdrawn.

The cited references fail to show, teach or make obvious the invention as claimed by Applicants. Further, none of the references cited anticipate nor make obvious the invention as presently claimed. For at least the reasons presented above, the rejection should be withdrawn.

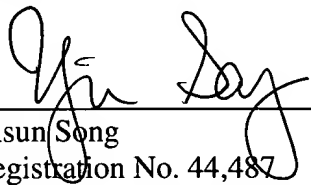
Dependent claims 59-65, 67-75 depend from either independent claims 58 or 66, respectively. As such, each of these dependent claims contain each of the features recited in the independent claims. For the reasons stated above, Moran combined with McGovern and further combined with VIP Forum fail to disclose the claimed inventions and the rejections should be withdrawn.

CONCLUSION

It is respectfully submitted that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,



Yisun Song
Registration No. 44,487
for Thomas J. Scott, Jr.
Registration No. 27,836

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
(202) 955-1966

Date: August 18, 2003